



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,149	02/09/2006	Pia Frei	5780	1148

26936 7590 11/16/2007
SHOEMAKER AND MATTARE, LTD
10 POST OFFICE ROAD - SUITE 110
SILVER SPRING, MD 20910

EXAMINER

CHEUNG, WILLIAM K

ART UNIT	PAPER NUMBER
----------	--------------

1796

MAIL DATE	DELIVERY MODE
-----------	---------------

11/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/563,149

Applicant(s)

FREI ET AL.

Examiner

William K. Cheung

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-17 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-17 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The examiner acknowledges the receipt of the amendment filed August 28, 2007.

Claims 11-17, 20-24 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 11-17, 20-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 11 (line 2-3), claim 12 (line 3), claim 16 (line 2), the recitation "a diblock fraction of more than 40%" is considered non-enabling because the specification fails to provide a way to define what "a diblock fraction" is, and a method of how it is determined or measured.

Applicant's arguments filed August 28, 2007 have been fully considered but they are not persuasive. Applicants argue that the recited "diblock content" of claim 11 is well known to the people of ordinary skill in the art to mean "portion of a block copolymer which is formed on only two blocks". However, applicants fail to recognize that a block copolymer can be considered either "a diblock copolymer" or "not a diblock copolymer", not something in between characterized by "a diblock content". If there is such a copolymer that is partially diblocked, applicants are required to provide experimental method in the specification to enable such characterization.

Regarding the list of patent numbers cited for the argument, applicants must recognize that patent applications are individually examined. Regarding the "diblock content" in Kraton TM D-1119P, applicants fail to recognize that Kraton TM D-1119P is a mixture of SIS triblock copolymer and SI diblock copolymer. However, there is not an indication that the claimed "an elastomeric block copolymer" is a mixture of triblock and diblock copolymers.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 11-13, 16-17, 20-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Wang (US 6,428,900 B1), for the reasons adequately set forth from paragraph 7 of the non-final office action of May 23, 2007.

*The invention of claims 11-24 relates to an **adhesive composition** containing*

*(a) **an elastomeric block copolymer** having a diblock content of more than 40%;*

*(b) **a sulfonated copolyester;***

(c) if desired, further auxiliary additives.

Wang (abstract; col. 1, line 5-22; col. 3, line 36 to col. 4, line 17) discloses a water-sensitive hot melt adhesive composition based on about 10% to about 90% by weight of one or more sulfonated polyester copolymer(s), and a broad range composition of plasticizer(s), tackifier(s), and stabilizer(s). Regarding the claimed elastomeric block copolymer, Wang (col. 17-18, claims 5-6) clearly teaches elastomeric block copolymers having a melting pointer greater than 50°C (solid at room temperature). Regarding claims 22-23, Wang (col. 1, line 23-46) discloses various applications that meet the features of claims 22-23. Regarding claim 24, Wang (col. 6, line 66 to col. 7, line 6) clearly discloses the use of multifunctional monomers for preparing the taught sulfonated polyesters. Therefore, the examiner has a reasonable basis that the claimed "branched" feature is inherently possessed in Wang. In view of

the broad range of composition of components (a) and (b) of claim 12, the rejection of claims 12, 13 by Wang is adequate and proper.

In view of the 112 rejection set forth, the claims are adequately anticipated by Wang.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 14, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (US 6,428,900 B1) for the reasons adequately set forth from paragraph 9 of the non-final office action of May 23, 2007.

Wang (abstract; col. 1, line 5-22; col. 3, line 36 to col. 4, line 17) discloses a water-sensitive hot melt adhesive composition based on about 10% to about 90% by weight of one or more sulfonated polyester copolymer(s), and a broad range composition of plasticizer(s), tackifier(s), and stabilizer(s). Wang (col. 6, line 66 to col. 7, line 6) clearly discloses the use of multifunctional monomers for preparing the tough sulfonated polyesters. Therefore, the examiner has a reasonable basis that the claimed "branched" feature is inherently possessed in Wang.

The difference between Wang and claims 14, 15 is that Wang discloses adhesive compositions do not contain an elastomeric styrene block copolymer or styrene-isoprene block copolymer.

However, Wang (col. 1, line 50) discloses other suitable polymers such as styrene-isoprene-styrene block copolymer for hot melt adhesive applications. In view of substantially identical utilities (or functions) between the styrene-isoprene-styrene block copolymer and the disclosed sulfonated polyester copolymers as taught in Wang, it would have been obvious to one of ordinary skill in art incorporate the styrene-isoprene-styrene block copolymer teachings or partially replace the sulfonated copolyester

component of adhesive composition of Wang with styrene-isoprene-styrene block copolymer to obtain the invention of claims 14, 15.

Response to Arguments

8. Applicant's arguments filed August 28, 2007 have been fully considered but they are not persuasive. Applicants argue that the recited "diblock content" of claim 11 is well known to the people of ordinary skill in the art to mean "portion of a block copolymer which is formed on only two blocks". However, applicants fail to recognize that a block copolymer can be considered either "a diblock copolymer" or "not a diblock copolymer", not something in between characterized by "a diblock content". If there is such a copolymer that is partially diblocked, applicants are required to provide experimental method in the specification to enable such characterization.

Regarding the list of patent numbers cited for the argument, applicants must recognize that patent applications are individually examined. Regarding the "diblock content" in Kraton TM D-1119P, applicants fail to recognize that Kraton TM D-1119P is a mixture of SIS triblock copolymer and SI diblock copolymer. However, there is not an indication that the claimed "an elastomeric block copolymer" is a mixture of triblock and diblock copolymers.

Applicants argue that Wang does not disclose the diblock fraction as claimed. However, it is unclear according to applicants' specification on how a diblock fraction is measured or obtained. Therefore, applicants' argument is not supported by the claims or by applicants' specification. Regarding applicants' argument that Wang (col. 1, line 59-62) teaches away from the instantly claimed invention. However, applicants fail to recognize that Wang does not indicate that the shortcomings are directly related to the styrene containing block copolymers. Regarding applicants' argument that the specification (2006/0211808, page 3, Table 1) contain unexpected results to show the criticality of the claimed invention, applicants fail to recognize that the argued Table 1 does not comprise a comparative example that is based on the teachings of Wang.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

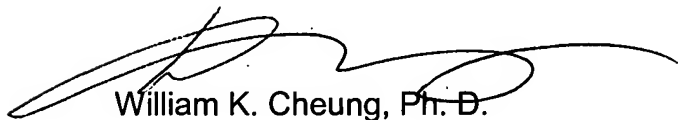
Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/563,149
Art Unit: 1796

Page 10

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



William K. Cheung, Ph. D.

Primary Examiner

November 4, 2007

WILLIAM K. CHEUNG
PRIMARY EXAMINER